

REMARKS

This is in full and timely response to the non-final Office Action mailed on December 19, 2003. Reexamination in light of the following remarks is respectfully requested.

Claims 15-17 are currently pending in this application, with claims 4, 5, 12, 16 and 17 being independent. No new matter has been added.

Rejection under 35 U.S.C. §102 and §103

Claims 1-11 were rejected under 35 U.S.C. §102 as allegedly being anticipated by U.S. Patent No. 5,991,747 to Tomoyuki et al. (Tomoyuki).

This rejection is traversed at least for the following reasons.

Claims 1-4

While not conceding the propriety of this rejection and in order to advance the prosecution of the above-identified application, claims 1-4 have been canceled without prejudice or disclaimer, rendering the rejection moot as to claims 1-4.

Claims 5-11

Claim 5 and the claims dependent thereon are drawn to a transaction method by means of an electronic device which contains monetary value as electronic money, characterized in that said transaction method accumulates the amount data equivalent to transaction amounts as installment transaction history data and receives part or all of the accumulated installment balance as a minimum payment.

Tomoyuki arguably teaches an electronic purse loan system wherein repayment may be set for payment in monthly installments and charges can be loaned many times within the term for repayment (column 8, lines 39-42). In addition, Tomoyuki arguably teaches that a repayment term storage may be provided in the personal information storage 34 in the center 3 (column 8, lines 42-46).

Nevertheless, accumulating the amount data equivalent to transaction amounts as installment transaction history data and receiving part or all of the accumulated installment balance as a minimum payment is not found within Tomoyuki. Instead, Tomoyuki arguably discloses that the suspension of a transaction due to a shortage in the balance can be avoided by providing a loan function in an electronic purse system.

Withdrawal of this rejection and allowance of the claims is respectfully requested.

Claim 10 was rejected under 35 U.S.C. §103 as allegedly being obvious over Tomoyuki.

This rejection is traversed at least for the following reasons.

The Office Action contends, without providing support, that contact-less data cards is an old and well-known type of card processing method in the chip and smart card computer art.

In response, this unsupported contention amounts to nothing more than conclusions that are personal in nature. In this regard, the teachings, suggestions or incentives supporting the obviousness-type rejection must be clear and particular. Broad conclusory statements, standing alone, are not evidence. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

As a rule, “assertions of technical facts in areas of esoteric technology must always be supported by citation to some reference work recognized as standard in the pertinent art and the appellant given, in the Patent Office, the opportunity to challenge the correctness of the assertion or the notoriety or repute of the cited reference.” (Citations omitted). *In re Pardo and Landau*, 214 USPQ 673, 677 (CCPA 1982). The support must have existed at the time the claimed invention was made. *In re Merck & Co., Inc.*, 231 USPQ 375, 379 (Fed. Cir. 1986).

“Allegations concerning specific ‘knowledge’ of the prior art, which might be peculiar to a particular art should also be supported and the appellant similarly given the opportunity to make a challenge.” (Citations omitted). *In re Pardo and Landau*, 214 USPQ 673, 677 (CCPA 1982).

In addition, "it is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps. The references themselves must provide some teaching whereby the applicant's combination would have been obvious" (citations omitted). *In re Gorman*, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). See also *In re Dembiczak*, 50 USPQ2d 1614, 1616 (Fed. Cir. 1999)(rejection based upon hindsight is reversed).

Moreover, the procedures established by Title 37 of the Code of Federal Regulations expressly entitle the Applicant to an Examiner's affidavit upon request. Specifically, "when a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons." 37 C.F.R. §1.104(d)(2).

Also note that the failure to provide any objective evidence to support the challenged use of Official Notice constitutes clear and reversible error. *Ex parte Natale*, 11 USPQ2d 1222, 1227-1228 (Bd. Pat. App. & Int. 1989).

Accordingly, Applicant hereby requests a reference or an Examiner's affidavit to support this officially noticed position of obviousness or what is well known. Further note that if this reference or Examiner's affidavit is not provided, the assertions of what is well known must be withdrawn. See M.P.E.P. §2144.03.

In addition, this assertion amounts to nothing more than an "obvious-to-try" situation. Specifically, "an 'obvious-to-try' situation exists when a general disclosure may pique the scientist's curiosity, such that further investigation might be done as a result of the disclosure, but the disclosure itself does not contain a sufficient teaching of how to obtain the desired result, or that the claimed result would be obtained if certain directions were pursued." *In re Eli Lilly & Co.*, 14 USPQ2d 1741, 1743 (Fed. Cir. 1990). Moreover, "an invention is 'obvious to try' where the prior art gives either no indication of which parameters are critical or no direction as to

which of many possible choices is likely to be successful." *Merck & Co. Inc. v. Biocraft Laboratories Inc.*, 10 USPQ2d 1843, 1845 (Fed. Cir. 1989).

Here, Applicants related art does not contain a sufficient teaching of how to obtain the desired result, or that the claimed result would be obtained if certain directions were pursued. "Obvious to try" is not the standard under §103. *In re O'Farrell*, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988). Withdrawal of this rejection and allowance of the claims is respectfully requested.

Newly added claims

Claim 12 and the claims dependent thereon are drawn to an electronic money system including electronic money terminals adapted to withdraw amount of money data equivalent to an amount of money used by a user from the amount of money data inputted in an information card, the system comprising:

means for accumulating installment transaction history data, each installment transaction history data including the amount of money data for payment by the information card when the payment by installments is selected;

means for receiving any part or all of an installment balance accumulated in the installment transaction history data, as an installment amount of payment;

an installment balance management means for determining a balance by subtracting the installment amount received by the receiving means, from the installment balance to send the installment balance of the information card; and

means for sending the installment transaction history data in the installment transaction history data accumulation means to the installment balance management means.

Tomoyuki arguably teaches an electronic purse loan system wherein repayment may be set for payment in monthly installments and charges can be loaned many times within the term for repayment (column 8, lines 39-42). In addition, Tomoyuki arguably teaches that a repayment term storage may be provided in the personal information storage 34 in the center 3

(column 8, lines 42-46).

Yet, Tomoyuki fails to disclose, teach or suggest an amount of money used by a user from the amount of money data inputted in an information card, and fails to disclose, teach or suggest means for receiving any part or all of an installment balance accumulated in the installment transaction history data, as an installment amount of payment. Instead, Tomoyuki arguably discloses that the suspension of a transaction due to a shortage in the balance can be avoided by providing a loan function in an electronic purse system.

Claim 16 is drawn to an electronic money terminal adapted to withdraw amount of money data equivalent to an amount of money used by a user from the amount of money data inputted in an information card, which terminal comprises:

means for accumulating installment transaction history data, each installment transaction history data including the amount of money data for payment by the information card when the payment by installments is selected; and

means for sending the installment transaction history data to an installment balance management means so as to determine an installment balance.

Tomoyuki arguably teaches an electronic purse loan system wherein repayment may be set for payment in monthly installments and charges can be loaned many times within the term for repayment (column 8, lines 39-42). In addition, Tomoyuki arguably teaches that a repayment term storage may be provided in the personal information storage 34 in the center 3 (column 8, lines 42-46).

Yet, Tomoyuki fails to disclose, teach or suggest an amount of money used by a user from the amount of money data inputted in an information card, and fails to disclose, teach or suggest means for accumulating installment transaction history data, each installment transaction history data including the amount of money data for payment by the information card when the payment by installments is selected; and means for sending the installment transaction history data to an installment balance management means so as to determine an installment balance.

Instead, Tomoyuki arguably discloses that the suspension of a transaction due to a shortage in the balance can be avoided by providing a loan function in an electronic purse system.

Claim 17 is drawn to a method of performing an electronic money system using an information card which stores data for electronic money, comprising the steps of:

selecting installments payment by using the information card;

conducting transaction by storing installment transaction history data on the amount of money data for payment;

accumulating the installment transaction history data to determine an installment balance of the information card;

paying an installment amount of payment which is any part or all of the installment balance; and

determining a balance of the information card by subtracting the installment amount paid from the installment balance.

Yet, Tomoyuki fails to disclose, teach or suggest selecting installments payment by using the information card. Instead, Tomoyuki arguably teaches an electronic purse loan system wherein repayment may be set for payment in monthly installments and charges can be loaned many times within the term for repayment (column 8, lines 39-42). In addition, Tomoyuki arguably teaches that a repayment term storage may be provided in the personal information storage 34 in the center 3 (column 8, lines 42-46). In addition, Tomoyuki arguably discloses that the suspension of a transaction due to a shortage in the balance can be avoided by providing a loan function in an electronic purse system.

Moreover, within the newly added claims, the installment transaction history data includes the amount of money data for payment by the information card when the payment by installments is selected, and the receiving means receives any part or all of an installment

balance accumulated in the installment transaction history data. The installment balance is determined by the installment balance management means. Allowance of the claims is respectfully requested.

Conclusion

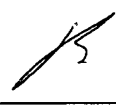
For the foregoing reasons, all the claims now pending in the present application are allowable, and the present application is in condition for allowance. Accordingly, favorable reexamination and reconsideration of the application in light of the amendments and remarks is courteously solicited.

If the Examiner has any comments or suggestions that could place this application in even better form, the Examiner is requested to telephone Brian K. Dutton, Reg. No. 47,255, at 202-955-8753 or the undersigned attorney at the below-listed number.

If any fee is required or any overpayment made, the Commissioner is hereby authorized to charge the fee or credit the overpayment to Deposit Account # 18-0013.

Dated: March 19, 2004

Respectfully submitted,

By 
Ronald P. Kananen
Registration No.: 24,104
Brian K. Dutton
Registration No.: 47,255
RADER, FISHMAN & GRAUER PLLC
1233 20th Street, N.W.
Suite 501
Washington, DC 20036
(202) 955-3750
Attorneys for Applicant